

## REMARKS

Pursuant to the present amendment, claims 2, 4, 6, 13, 15, 21, 23, and 37-38 have been amended. No new matter has been introduced by the present amendment. Thus, claims 1-47 are pending in the present application. Reconsideration of the application is respectfully requested.

In the Office Action, the Examiner objected to claims 2, 4, 6, 13, 15, 21, 23, and 37-38 as being dependent upon a rejected base claim, but indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 2, 4, 6, 13, 15, 21, 23, and 37-38 have been amended to present these claims in independent form. Accordingly, Applicants respectfully submit that claims 2, 4, 6, 13, 15, 21, 23, and 37-38 are in condition for allowance. Applicants respectfully request that the Examiner's objections to these claims be withdrawn.

In the Office Action, claims 1, 3, 5, 7, 27, 29, 32, 34, and 42-45 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Nguyen, et al (U.S. Patent No. 6,179,256). The Examiner's rejections are respectfully traversed.

By way of background, the present invention is generally directed to determining grid dimensions on a wafer having a test structure including a plurality of intersecting lines that define a grid having openings. In contrast, Nguyen is directed to measuring critical dimensions of reticle patterns formed by a lithographic printer. Nguyen describes transferring a grid pattern of a reticle 210 to a substrate 214. The reticle 210 is then rotated to a second orientation and a second grid pattern is transferred to the substrate 214. Critical dimensions of the transferred grid patterns may then be measured. See Nguyen, col. 7, l. 61 – col. 8, l. 62 and Figure 4. However, Nguyen does not describe or suggest providing a wafer having a test structure comprising a plurality of intersecting lines that define a grid having openings, as set forth in claims 1-47.

In the Final Office Action, the Examiner alleges that the grid described by Nguyen inherently includes openings. In support of this allegation, the Examiner notes that Plettner (U.S. Patent No. 5,985,739) describes a metal layer 33 provided in the shape of the grid and then states that “grid-shaped generally means a layer penetrated by openings.” See Plettner, col. 4, ll. 39-44. However, as the Examiner well knows, inherency in anticipation requires that the asserted proposition *necessarily* flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. (BNA) 323, 326 (C.C.P.A. 1981); *Levy*, 17 U.S.P.Q.2d (BNA) at 1463-64; *Skinner*, at 1789; *In re King*, 231 U.S.P.Q. (BNA) 136, 138 (Fed. Cir. 1986). Applicants note that the Examiner’s definition of the term “grid” is much narrower than commonly accepted definitions of this term. For example, *Merriam-Webster’s Collegiate Dictionary, 10<sup>th</sup> edition*, defines a grid as “a network of uniformly spaced horizontal and perpendicular lines” or “something resembling such a network.” Thus, commonly accepted definitions of the term “grid” do not require that the grid have openings. Applicants respectfully submit that the Examiner has failed to provide any suggestion or motivation for applying the narrow definition of “grid” set forth in Plettner in any other context. In particular, Plettner provides absolutely no teaching that the grid described by Nguyen includes openings.

Nguyen, on the other hand, states that the grid does not have openings. In particular, Nguyen teaches that each portion of the reticle field includes a pattern that may be transferred to a substrate 214 via an imaging system such as a lens 216. Each portion of the die ( $X_i, Y_i$ ) corresponds to a similar point in the image field and critical field. Thus, the grids described by Nguyen (either in the reticle field, the image field, or on the die) are filled by the pattern.

For at least these reasons, Applicants respectfully submit that the Examiner has failed to establish that the asserted proposition, *i.e.* that the grid described by Nguyen includes openings,

*necessarily* flows from the disclosure of Nguyen, and therefore has failed to establish that Nguyen inherently discloses a grid including openings. Accordingly, Applicants respectfully submit that the present invention is not anticipated by Nguyen and request that the Examiner's rejections of claims 1, 3, 5, 7, 27, 29, 32, 34, and 42-45 under 35 U.S.C. § 102(e) be withdrawn.

In the Office Action, claims 2, 8, 10-12, 14, 16, 18-20, 22, 24, 26, 28, 30-31, 33, 35-36, 40, 46, and 47 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nguyen in view of Stirton (U.S. Patent No. 6,614,540). Claims 9 and 39 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nguyen in view of Mita, et al (U.S. Patent No. 4,547,895). Claims 17 and 25 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nguyen in view of Stirton and further in view of Mita. The Examiner's rejections are respectfully traversed.

Submitted herewith are the declarations under 37 C.F.R. § 1.131 of the one of the named inventors, Richard J. Markle, and of the undersigned attorney that recite facts that establish that the Nguyen patent is only available as prior art to the present application under 35 U.S.C. 102(e). More particularly, the declarations establish that, prior to January 23, 2001, the issue date of the Nguyen patent, the invention disclosed in the pending application was conceived and that all parties involved in preparing and filing the patent application with the United States Patent and Trademark Office were diligent. Accordingly, the Nguyen patent is only available as prior art to the present application under 35 U.S.C. 102(e).

According to MPEP §706.02(l)(1), "effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention 'were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to

the same person.' ” The present application was filed on or after November 29, 1999. Furthermore, the present application and Nguyen were, at the time the present invention was made, owned by the same entity or subject to an obligation of assignment to the same entity. Thus, Applicants respectfully submit that Nguyen is not available as prior art in any obviousness determination. Applicants respectfully request that the Examiner's rejections of claims 2, 8-12, 14, 16-20, 22, 24-26, 28, 30-31, 33, 35-36, 39-40, 46, and 47 under 35 U.S.C. § 103(a) be withdrawn.

In view of the remarks set forth herein, the application is believed to be in condition for allowance and notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

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